

Remarks

The claims were amended in accordance with the amendments above. The amendments are being made to clarify the invention. The amendments are fully supported by the specification, claims, and figures as originally filed. No new matter is believed or intended to be involved.

Applicant appreciates the courtesies extended during the telephonic interview with the Examiner on 06/26/2007. The claims were amended as discussed in the interview. Applicant appreciates the Examiner's indication during the interview that the present amendments to claims 38 and 42 would require a supplemental search, and that the amendments to claim 22 would warrant further consideration.

In the Office Action dated 12/28/2006, claims 22-27, 29, and 37 were rejected under 35 USC §103(a) as being unpatentable over Cash (US 6,517,406), Burton (D394,479), Kimbrough (US 5,926,388), and Wolf (US 6,655,056). Claims 28 and 30-31 were rejected under 35 USC §103(a) as being unpatentable over Cash, Kimbrough, Wolf, and Lerner (US 3,660,926). Claim 32 was rejected under 35 USC §103(a) as being unpatentable over Cash, Kimbrough, and Wolf. Claims 33-34 were rejected in view Cash, Burton, Kimbrough, Wolf, and further in view of Official Notice. Claims 35-36 were rejected in view Cash, Burton, Kimbrough, and Wolf. Claims 38-40 were rejected under 35 USC §103(a) as being unpatentable over Cash, Burton, and Kimbrough. Claims 41-43 were rejected under 35 USC §103(a) as being unpatentable over Cash, Burton, Kimbrough, and Lerner. For at least the reasons set forth below, Applicant respectfully traverses these rejections.

Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching, suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The

mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01.

Applicant submits that the art of record fails to teach or suggest all of the limitations recited in each independent claim in accordance with MPEP 2143.03. For instance, Applicant notes that independent claim 22 recites a specific formula that certain volumes are configured to be consistent with in order to result in the combined ball and face being generally the size of the head of the athlete. These limitations, among others recited in claim 22, are neither taught nor suggested by the combined art of record. Applicant therefore submits that the combined art of record fails to teach or suggest all of the limitations of claim 22 in accordance with MPEP 2143.03. Accordingly, Applicant respectfully submits that the combined art of record fails to render present claim 22 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Similarly, independent claims 38 and 41 each recite the three-dimensional representation of the article of fame being reversible to reveal a second three-dimensional representation of the face of the famous person. These limitations, among others recited in claims 38 and 41, are neither taught nor suggested by the combined art of record. Applicant therefore submits that the combined art of record fails to teach or suggest all of the limitations of claims 38 and 41 in accordance with MPEP 2143.03. Accordingly, Applicant respectfully submits that the combined art of record fails to render present claims 38 and 41 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn.

Even if all of the references in combination taught or suggested all of the limitations recited in the amended claims, the Office has failed to establish the motivation to modify or combine the teachings of the references as required by MPEP 2143, and has instead relied upon impermissible hindsight reconstruction in declaring the claimed invention obvious. Indeed, MPEP 2143.01 admonishes that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (emphasis in original). *Actual evidence* of a suggestion, teaching or motivation to combine prior art references must be shown. *In re Dembiczak*, 50

USPQ2d 1614 (Fed.Cir. 1999). Broad *conclusory statements* regarding the teaching of references, standing alone, simply *are not evidence*. *Id.* Rather than being based in evidence in the record, the motivation provided by the Office appears to be based solely on a subjective opinion of an individual examiner rendered over 4 years after the priority/filing date of the present application. This falls far short of the requirements of MPEP 2143.01. *See In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999). Ultimately, the Office has failed to provide the requisite *evidence* in the prior art suggesting the desirability of the combinations claimed herein. Because the motivation required by MPEP 2143.01 is lacking, Applicant respectfully requests that the rejections be withdrawn.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for non-obviousness.

Conclusion

While several distinctions have been noted over the art of record, Applicant notes that there are several other limitations recited in the present claims which are neither taught nor suggested by the art of record. Applicant expressly reserves all rights and arguments with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'A B Ulmer', written over a horizontal line.

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